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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,137	07/11/2001	Christopher M. Tobin	50P4390	2542

530 7590 08/14/2006

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EXAMINER

VIG, NARESH

ART UNIT PAPER NUMBER

3629

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/903,137	Applicant(s) TOBIN ET AL.	
	Examiner Naresh Vig	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 49-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in reference to response received 26 May 2006. Cancellation of claims 25-48 and addition of new claims 49-51 is acknowledged. Claims 1-24 and 49-51 are pending for examination.

Applicant has not amended previously submitted pending claims 1-24. Upon review of newly added claims 49 which claims dependency on claim 1, claim 50 which claims dependency on claim 11, and, claim 51 which claims dependency on claim 18, the newly added claims when written in independent form are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims originally presented claimed the limitation "providing a particular credit to the user based upon receipt of the identifier, wherein the particular credit is usable for receiving the particular content through the electronic content distribution system". Newly submitted pending claims recite a new limitation, "particular credit is representative of a discount applied to the purchase of the particular content". This clearly demonstrates that the user has made a purchase and the discount is applied to the purchase made by the user.

Also, in the disclosure originally filed 11 July 2001, applicant recites "The content distribution management module 314 and/or the content player application (224, FIG. 2) are configured to recognize a particular compact disc (or other optical storage medium, such as a DVD) and provide a credit usable towards usage rights for related content" [0028]. In addition, "credit" is a

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deduction of payment, whereas, "discount" is to sell or offer for sale at a reduced price. In the originally presented case upon which an office action was issued, applicant had not positively claimed a user to make a purchase for which a discount will be applied.

Therefore the newly submitted pending claims are distinct and divergent from the earlier claimed inventions and would require a new, divergent and different search. Such change in the inventions amount to a "Shift claiming another invention after an action given on the claimed subject matter and are therefore subject to "Election by Original Presentation". as analyzed above.

Kindly refer to the following MPEP excerpts for guidelines:

819 Office Generally Does Not Permit Shift:

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. **Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right).** When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in **MPEP § 821.03**.

Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. Ex *pane Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

821.03 Claims for Different Invention Added After an Office Action

Claims added by amendment following action by the examiner, **MPEP § 818.01, § 818.02(a)**, to an invention other than previously claimed, should be treated as indicated by **37 CFR 1.145**.

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37 CFR 1.145 Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ **1.143 and 1.144**

Therefore, newly submitted claims are directed to an invention that is independent or distinct from the invention originally claimed for the reasons given above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, pending claims are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The amendment presenting only claims drawn to a nonelected invention is non-responsive (MPEP § 821.03). The currently newly added pending claims are not readable on the elected invention because they are subject to " Election by Original Presentation". as analyzed above.

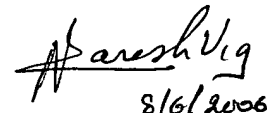
Since the above-mentioned amendment appears to be a bona fide attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



8/6/2006

Naresh Vig
Examiner
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